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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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# Office Action Summary

**Application No.**

10/753,062

**Applicant(s)**

OSADA, MAMORU

**Examiner**

CHRISTOPHER C. JOHNS

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Acknowledgements*

1. This Office Action is given Paper No. 20110607 for reference purposes only.
2. This Office Action is in response to Applicant's response to non-final rejection, filed on 17 January 2011 ("January 2011 Response"). The January 2011 Response contained, inter alia, claim amendments ("January 2011 Amendments") and remarks ("January 2011 Remarks").
3. All references to the capitalized version of "Applicant" refer specifically to the Applicant of record in the instant application. Any references to lowercase versions of "applicant" or "applicants" refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 11-19 are pending.
5. Claim 11 was previously withdrawn as of Applicant's election of 3 September 2010.
6. Claims 12-19 have been examined.
7. **Please note:** The Examiner in this case has changed to Christopher Johns. Please address all future correspondence to Examiner Johns, whose contact information is contained at the end of this Action.

### *Claim Rejections - 35 USC § 112 First Paragraph*

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 12-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

10. Independent claim 12 recites “error terminate the program module, when the first determination determines that the total number of the print surfaces indicated in the updated record of the program module exceeds the counted total number of the print surfaces” (page 4, lines 23-25). The originally-filed specification lacks clear support for this particular recitation. That is, while the specification discloses that “error [termination]” is reached based on the results of comparing a total number of print surfaces with the allowed number of print surfaces, the Examiner notes that the claim language recites that an “error termination” state is reached when the number of surfaces that the printer is allowed to print **exceeds** the number of surfaces the printer has printed, while the specification recites that the “error termination” state is reached when the number of surfaces that the printer is allowed to print **is exceeded by** the number of surfaces the printer has printed

11. The Examiner finds that “error terminate the program module, when the first determination determines that the total number of the print surfaces indicated in the updated record of the program module exceeds the counted total number of the print surfaces” means that the program module terminates only when the number of allowed printings (i.e. the “total number of the print surfaces indicated in the updated record of the program module”) **exceeds**

the number of printings that have actually occurred (i.e. the “counted total number of the print surfaces”).

12. The specification, at [0124] recites that the program reaches an “error termination” state if the number of allowed printings **is exceeded by** the number of printings that have actually occurred. [0124] recites that a “determination is carried out by comparing the total print surface count 84 associated with the relevant module ID in the management information 80 with the total print surface count 1802 [thus determining] whether or not the total print surface count has exceeded its limit. If the total print surface count has not exceeded its limit, the process proceeds to a step S1906 [where more tests are done].” Figure 20 notes that if the “LIMIT” is **less than** “TOTAL PRINT SURFACE COUNT,” (see step S1905, result “NO”) the program continues. Only if the “TOTAL PRINT SURFACE COUNT” **exceeds** the “LIMIT” does the program go to “Error Termination” (step S1910).

13. Because claim 12 recites that an error termination state is reached when the number of pages printed **is exceeded by** the limitation on pages, and because the specification and figure 20 recite that an error termination state is reached when the number of pages printed **exceeds** the limitation on pages, claim 12 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Claim 13 contains a similar recitation (page 6, lines 19-22) and is therefore rejected for similar reasons..

14. In order to obviate this rejection, the Examiner recommends amending claims 12 and 13 to recite that an “error termination” state is reached when the print surface count exceeds the print surface limit.

***Claim Rejections - 35 USC § 112 Second Paragraph***

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Independent claim 12 recites “generating device adapted to encrypt an input licensing condition and generate license information for controlling the program module to start the license information, which includes the encrypted license condition...” (page 3, lines 7-13). The recitation of “generating device adapted to encrypt an input licensing condition and generate license information for controlling the program module to start the license information, which includes the encrypted license condition...” renders the claim indefinite because a person having ordinary skill in the art would not understand whether:

- a. “to start the license information” is meant to modify “generating device adapted to...,” as in “a generating device adapted to...start the license information;”
- b. “to start the license information” is meant to modify “generate license information...,” as in “generating device adapted to...generate license information...to start the license information;” or

c. “to start the license information” is meant to modify “for controlling the program module...,” as in “generating device adapted to...generate license information for controlling the program module to start the license information....”

18. Because a person having ordinary skill in the art’s attempt to interpret the claim language would result in two or more structurally dissimilar interpretations, the claim language is indefinite. As such, the USPTO is justified in requiring the Applicant to more precisely define the metes and bounds of the claimed invention. See *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008). For further guidance on this matter, see page 2, ¶1 of “Indefiniteness rejections under 35 U.S.C. 112, second paragraph (signed 2 September 2008),” located at the USPTO’s website: <http://www.uspto.gov/web/patents/memoranda.htm>. Claim 13 contains a similar recitation (page 5, lines 2-6) and is therefore rejected for similar reasons.

19. Independent claim 12 recites “generating device adapted to encrypt an input licensing condition and generate license information for controlling the program module to start the license information, which includes the encrypted license condition...” (page 3, lines 7-13). The recitation of “generating device adapted to encrypt an input licensing condition and generate license information for controlling the program module to start the license information, which includes the encrypted license condition...” renders the claim indefinite because a person having ordinary skill in the art would not be able to reasonably understand the structure of “**start[ing]** the license information.”

d. The Examiner finds that “information” is defined as “2 a . . . (3): FACTS, DATA . . . .” See Merriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

- e. The Examiner finds that “start” is defined as “to come into being, activity, or operation.” See *id.*
20. Because information is merely data, and because “start” is defined as “to come into...operation,” a person having ordinary skill in the art would not understand the structure of data coming into operation. Claim 13 contains a similar recitation (page 5, lines 2-6) and is therefore rejected for similar reasons.
21. Claim 12 recites “generating device adapted to encrypt an input licensing condition and generate license information....wherein the license condition includes a module ID of the program module...” (page 3, lines 7-15). The recitation of “generating device adapted to encrypt an input licensing condition and generate license information....wherein the **license condition** includes a module ID of the program module...” renders the claim indefinite because a person having ordinary skill in the art would not understand whether “license condition” refers to the “licensing condition” or to the “license information” generated from the licensing condition.
- f. Evidence tending to show that the term “license condition” refers to the “input licensing condition” is that “license **condition**” contains the word “**condition**” as in “input licensing **condition**” (and not “information”).
- g. Evidence tending to show that the term “license condition” refers to the “license information” is that “**license condition**” contains the word “**license**” as in “**license information**” (and not “licensing”).
22. Given this contradictory evidence, the Examiner finds that a person having ordinary skill in the art would not understand which of the two interpretations is the valid interpretation. The



claim is thus rendered indefinite because a person having ordinary skill in the art would not reasonably be able to determine the structure of claim 12. Claim 13 contains a similar recitation (page 5, lines 1-8) and is thus rejected for similar reasons.

23. To obviate this particular rejection, the Examiner suggests amending “license condition” to read either “license information” or “input licensing condition.”

24. Claim 12 recites “first controller is adapted to: obtain the license information from the information processing apparatus to decrypt the encrypted licensing condition included in the obtained license information” (page 3, lines 22-24). The recitation of “first controller is adapted to: obtain the license information from the information processing apparatus to decrypt the encrypted licensing condition included in the obtained license information” renders the claim indefinite because a person having ordinary skill in the art would not understand whether this means:

h. the first controller is adapted to obtain the license information, such that the act of obtaining the license information is done “to decrypt the encrypted licensing condition,”  
or

i. the first controller is adapted to obtain the license information, and is further adapted to decrypt the encrypted licensing condition.

25. Because a person having ordinary skill in the art’s attempt to interpret the claim language would result in two or more structurally dissimilar interpretations, the claim language is indefinite. As such, the USPTO is justified in requiring the Applicant to more precisely define the metes and bounds of the claimed invention. See again *Miyazaki*.

26. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 12-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,512,894 ("Takemoto") in view of U.S. Patent 6,597,469 ("Kuroyanagi").

29. As per claim 12, Takemoto discloses:

30. an image forming apparatus (figure 5, Image Forming Apparatus **100**) having a first controller (figure 5, License Information Reading Means **72**) and a program module (figure 5, Control Means **16**), wherein the program module is adapted to control a printer engine (figure 5, Image Forming Means **50**) to carry out a printing process (column 30, lines 12-15 - "allows full functions of image forming means **50**");

31. an information processing apparatus (figure 5, License Granting Server **81**), comprising: a generating device (the License Granting Server inherently contains software to create and send

the licenses, because computers inherently contain software because this is how computers are able to process and store and/or send data) adapted to encrypt an input licensing condition (column 29, lines 43-47 note that the “license information” is “encrypted license information;” thus, the License Granting Server **81** which creates the information must inherently encrypt the information) and generate license information (column 25, line 31 - “license information is **generated**”), for controlling the program module to start the license information (column 30, lines 9-15 - “in case both [the license information and the electronic information] conform to each other...the control means allows full functions of image forming means 50 so as to **start image forming operation**”), which includes the encrypted licensing condition (the “encrypted license information” includes “readable license information” when decrypted using a key - see column 29, lines 53-57);

32. wherein the license condition includes a module ID (column 16, lines 19-25 - “license information has ID numbers”) of the program module;

33. wherein the first controller is adapted to: obtain the license information from the information processing apparatus (column 29, lines 43-47 - “license information is read by the license information reading means 12 as encrypted license information”) to decrypt the encrypted licensing condition included in the obtained license information (column 29, lines 43-47 - “, and this encrypted license information is transmitted to decrypting means 17, then the [decrypted] information is transmitted to the comparing means 15”);

34. update (figure 6, **Memorize Cartridge ID Number & “License Available” In Electronic Information Memorizing Means**) a record (figure 6, “**Electronic Information Memorizing Means**”) for managing used resources of the program module based on the module

ID of the decrypted licensing condition included in the obtained license information (column 16, lines 18-25 - “license information has **ID numbers**, the electronic information is **preferably ID number**....if the electronic information and the license information conform to each other, the license information can be recognized as authentic”).

35. Takemoto does not explicitly disclose:
36. license condition has a total number of print surfaces the program module is allowed to process;
37. count up a total number of print surfaces printed in the printing process carried out by the printer engine;
38. compare the total number of the print surfaces included in the updated record of the program module to perform a first determination of determining whether the total number of the print surfaces included in the updated record of the program module exceeds the total number of the counted print surfaces;
39. error terminate the program module, when the first determination determines that the total number of the print surfaces indicated in the updated record of the program module exceeds the counted total number of the print surfaces.
40. Kuroyanagi teaches:
41. license condition has a total number of print surfaces the program module is allowed to process (figure 5, Answer From Print Server? 8);

42. count up (figure 6, Calculate  $t \leftarrow (i\text{-th Monochrome Counter}) + (i\text{-th Color Count})$  **19**) a total number of print surfaces (figure 6, “t” in **19**) printed in the printing process carried out by the printer engine (column 23, lines 45-47 - “At Step (19) the departmental counter table 340 is searched and a **total sum . . . is assigned to the variable t**”);
43. compare (figure 6, t : Limit Value? **20**) the total number of the print surfaces included in the updated record of the program module (figure 6, Limit Value in **20**) to perform a first determination of determining whether the total number of the print surfaces included in the updated record of the program module (figure 6, Limit Value in **20**) exceeds (figure 6; note how step **20** can go either towards “less than or equal to” (arrow with “ $\leq$ ”) or “greater than” (arrow with “ $>$ ”)) the total number of the counted print surfaces (figure 6, “t” in **20**);
44. error terminate the program module (figure 6, “END”), when the first determination determines that the total number of the print surfaces indicated in the updated record of the program module exceeds the counted total number of the print surfaces (note that when  $t \leq$  Limit Value (figure 6, step **20**), the program ends in an END step when the index is more than the Registered Maximum Number).
45. Kuronayagi’s print server allows for composite print job tracking to occur over a network. The print server allows for a user’s usage at multiple copiers to be accounted for, such that he cannot “change” copiers in order to get around a copier-imposed limitation on the number of pages (column 2, lines 1-6). This creates a more efficient system where users would not be able to get around a local limit on the number of pages they can print; rather, the print server would enforce a system-wide limit on the users. This would create a more cost-effective system because users would truly be limited in how many pages they could print.

46. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Takemoto the print server-tied system as taught by Kuroyanagi, since the claimed invention is merely a combination of old elements, and in the combination, Kuronayagi's print server merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable.

47. Additionally, a person having ordinary skill in the art would have recognized that the results of the combination were advantageous because it would create a more efficient and cost-effective system.

48. The Examiner finds that claim 13 is not patentably distinct from claim 12, because the inventions in claims 12 and 13 are related as process and apparatus for its practice. The inventions would be distinct if it could be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the system in claim 12 could not practice a materially different method from the one in claim 13, and the method in claim 13 could not be practiced by another and materially different apparatus from the one in claim 12.

49. Because claim 13 is not patentably distinct from claim 12, the Examiner concludes that the patentability of claim 13 stands or falls with claim 12.

50. As per claim 14, Takemoto in view of Kuroyanagi discloses as above, and further discloses:

51. wherein the first controller performs the first determination every time when the first controller updates the record for managing the used resources and counts up the total number (Kuroyanagi, figure 6; note how step 20 always follows step 19).

52. As per claim 17, Takemoto in view of Kuroyanagi discloses as above, and further discloses:

53. wherein the determining step performs the first determination every time the updating step updates the record for managing the used resources and the counting step counts up the total number (Kuroyanagi, figure 6; note how step 20 always follows step 19).

54. Claims 15 and 18 are rejected as being unpatentable over Takemoto in view of Kuroyanagi, further in view of U.S. Patent 5,115,234 ("Levinski").

55. As per claim 15, Takemoto in view of Kuroyanagi discloses as above, but does not explicitly disclose:

56. the program module further controls a scanner engine to carry out a scanning process;

57. the first controller is further adapted to count up the total number of the original surfaces scanned in the scanning process carried out by the scanner engine;

58. the first controller compares the total number of the original surfaces indicated in the updated record of the program module and the counted total number of the original surfaces to perform a second determination of determining whether the total number of the original surfaces

indicated in the updated record of the program module exceeds the counted total number of the original surfaces.

59. Levinski teaches:

60. the program module further controls a scanner engine (column 1, lines 30-40 - “an original is placed in a **facsimile style feeder**, where it is scanned as it is slowly drawn into the machine”) to carry out a scanning process (column 1, lines 38-45 - “a **master is prepared from the scanned original . . .**”);

61. the first controller is further adapted to count up the total number of the original surfaces scanned in the scanning process carried out by the scanner engine (columns 9-10, lines 15-20 - “if incoming pulse is a master pulse, then **increment master total**”);

62. the first controller compares the total number of the original surfaces indicated in the updated record of the program module (columns 9-10, lines 31-35 - “account master limit”) and the counted total number of the original surfaces (columns 9-10, lines 31-33 - “account master total”) to perform a second determination of determining whether the total number of the original surfaces indicated in the updated record of the program module exceeds the counted total number of the original surfaces (columns 9-10, lines 31-35 - “**compare account master total to account master limit**”).

63. The system in Levinski allows for both “masters [i.e. scanning of documents] and copies [i.e. printing of documents] to be counted “for subsequent review” (column 2, lines 29-34). Levinski notes that creating the master “typically costs from \$0.30 to \$0.75 to produce and cannot be reused” (column 1, lines 65-67), and so should be used as much as possible. The



limits on master production in Levinski thus create a more cost-effective system, because the number of “master” scans is counted and compared to a limit in order to determine whether the creation of such masters is cost-effective or not.

64. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Takemoto and Kuroyanagi the master-counting system as taught by Levinski, since the claimed invention is merely a combination of old elements, and in the combination, Levinski’s master-counting system merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable.

65. Additionally, a person having ordinary skill in the art would have recognized that the results of the combination were advantageous because it would create a more cost-effective system.

66. As per claim 18, Takemoto in view of Kuroyanagi, further in view of Levinski discloses as above, and further discloses:

67. the program module further controls a scanner engine (column 1, lines 30-40 - “an original is placed in a **facsimile style feeder**, where it is scanned as it is slowly drawn into the machine”) to carry out a scanning process (column 1, lines 38-45 - “a **master is prepared from the scanned original . . .**”);

68. the counting step further count[s] up the total number of the original surfaces scanned in the scanning process carried out by the scanner engine (columns 9-10, lines 15-20 - “if incoming pulse is a master pulse, then **increment master total**”);

69. the determining step compares the total number of the original surfaces indicated in the updated record of the program module (columns 9-10, lines 31-35 - "account master limit") and the counted total number of the original surfaces (columns 9-10, lines 31-33 - "account master total") to perform a second determination of determining whether the total number of the original surfaces indicated in the updated record of the program module exceeds the counted total number of the original surfaces (columns 9-10, lines 31-35 - "**compare** account master total **to** account master limit").

70. Claims 16 and 19 are rejected as being unpatentable over Takemoto in view of Kuroyanagi, further in view of Levinski, further in view of Official Notice.

71. As per claim 16, Takemoto in view of Kuroyanagi, further in view of Levinski, discloses as above, but does not explicitly disclose:

72. the first controller further performs a third determination of determining, based on the module ID, whether or not the total number of the print surfaces the program module allowed to process should be compared in the first determination, and when the third determination determines not to process, the first controller skips the first determination;

73. the first controller further performs a fourth determination of determining, based on the module ID, whether or not the total number of the original surfaces the program module allowed to process should be compared in the first determination, and when the fourth determination determines not to process, the first controller skips the second determination.

74. The Examiner takes Official Notice that determining whether or not a comparison should be made between printed pages and an allowed number of pages to be printed was old and well-

known in the art because it creates a more efficient system. That is, in situations where use of a copier is unlimited (i.e. where the "limit" is equal to infinity), the copy machine/printer would not need to check whether the number of printed pages is less than the limit, because *any* printed page count will inherently be less than a limit of "unlimited." Determining whether or not to make a comparison would create a more efficient system, something that a person having ordinary skill in the art would appreciate as advantageous because it would create a faster-operating system (by saving a step each time a page is printed or scanned).

75. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Takemoto, Kuroyanagi, and Levinski a determination step of determining whether or not to compare the number of printed surfaces to the number of allowable print surfaces, since the claimed invention is merely a combination of old elements, and in the combination, a determination of whether or not to compare such numbers merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable.

76. Additionally, a person having ordinary skill in the art would have recognized that the results of the combination were advantageous because it would create a more efficient system.

77. The Examiner finds that claim 19 is not patentably distinct from claim 16, because the inventions in claims 16 and 19 are related as process and apparatus for its practice. The inventions would be distinct if it could be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case the system in claim 16 could not practice a materially different method from the one in claim 19, and the method in claim 19 could not be practiced by another and materially different apparatus from the one in claim 16.

78. Because claim 16 is not patentably distinct from claim 19, the Examiner concludes that the patentability of claim 19 stands or falls with claim 16.

79. To support the rejections of claims 12-19, in the event of an appeal to the USPTO's Board of Patent Appeals and Interferences, and in addition to the particular citations noted above, the Examiner hereby cites to Takemoto: figures 1-9 and columns 1-34; Kuroyanagi: figures 1-7 and columns 1-40, as well as the Certificate of Correction certified 22 July 2003; and Levinski: figures 1 to 2-2 and columns 1-28, as well as the Certificate of Correction certified 19 May 1992.

### ***Claim Interpretation***

80. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

81. ***Adapt***: “to make fit (as for a specific or new use or situation) often by modification.”  
Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.

82. ***Controller***: “A device on which other devices rely for access to a computer sub-system.”  
Microsoft Computer Dictionary, 3<sup>rd</sup> Edition, Microsoft Press, Redmond, WA, 1997.

83. **Device:** "A generic term for a computer subsystem." Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.
84. **For:** "1 a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.
85. **Method:** "1 b (1): a way, technique, or process of or for doing something." Merriam-Webster's Collegiate Dictionary, 10th Edition, Merriam-Webster Incorporated, Springfield MA, 1997.
86. **Module:** "1. In programming, a collection of routines and data structures that performs a particular task or implements a particular abstract data type." Microsoft Computer Dictionary, 5<sup>th</sup> Edition, Microsoft Press, Redmond, WA, 2002.
87. **Start:** "to come into being, activity, or operation." Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Edition, Merriam-Webster Inc., Springfield, M.A., 1997.
88. **System:** "any collection of component elements that work together to perform a task. Examples are a hardware system consisting of a microprocessor, its allied chips and circuitry, input and output devices, and peripheral devices; an operating system consisting of a set of programs and data files; or a database management system used to process specific kinds of information". Microsoft Computer Dictionary, 5<sup>th</sup> Edition, Microsoft Press, Redmond, WA, 2002.
89. **To:** "2a -- used as a function word to indicate purpose, intention, tendency, result, or end." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

90. Regarding system claims 12 and 14-16, Applicant is reminded that “[a] system is an apparatus.” *Ex parte Fressola*, 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). “Claims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Additionally, products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. In light of the above, it is the Examiner's position that Applicant's “system” claims are apparatus, product, or more specifically, “machine” claims.

#### ***Response to Arguments***

91. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

#### ***Conclusion***

92. Applicant is respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that - suggestions or examples - and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action, or in any future Office Action, does not constitute a formal requirement mandated by the Examiner.

- j. Should Applicant decide to amend the claims, Applicant is also reminded that - as always - no new matter is allowed. The Examiner therefore leaves it up to Applicant to

choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. §112, 1<sup>st</sup> paragraph.

k. Independent of the requirements under 35 U.S.C. §112, 1<sup>st</sup> paragraph, Applicant is also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicant amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent 'Objection to the Specification' in the next office action, Applicant is encouraged to either (1) re-evaluate the amendment and change the claim language so the claims do have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicant choose to amend the specification, Applicant is reminded that - as always - no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicant has any questions on this matter, Applicant is encouraged to contact the Examiner via the telephone number listed below.

93. Applicant's amendment, filed on 17 January 2011, necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

94. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

95. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to CHRISTOPHER C. JOHNS whose telephone number is (571)270-3462. The Examiner can normally be reached on Monday-Friday, 8am-4pm. The Examiner's direct fax line is (571) 270-4462.

96. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

97. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated



information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621